

REMARKS

Prior to the present response, claims 1-20 were pending. By way of the above amendments, the invention title and the abstract have been amended, claims 1-10, 15-17, 19 and 20 have been amended, and new claims 21-34 have been added. Accordingly, claims 1-34 are currently pending. Favorable reconsideration is respectfully requested in view of the remarks that follow.

Independent claim 1 has been amended to recite a memory for storing data for facilitating a financial transaction originating from a payer in a computer network. The memory comprises a data structure for access by a payer to initiate a financial transaction originating from the payer, and that the data structure includes a personal payment number format. Support for this amendment can be found throughout the originally filed disclosure, for example, in the specification on page 6, lines 10-27, page 7, line 24 to page 8, line 5, page 9, lines 11-21 and page 10, lines 10-18 and Figure 2. Dependent claims 2-9 have been amended so as to conform to the amended subject matter of independent claim 1. Dependent claim 9 has been amended to correct a typographical error in its dependency.

Independent claims 10 and 17 have been amended to further clarify that each allocated personal payment numbers includes routing information and information identifying an account associated with a payee, that a personal payment number transaction originates from a payer utilizing an allocated personal payment number and that the transaction is routed to a destination based on the routing information included in the allocated personal payment number. Amendments to claims 10 and 17 further recite processing the personal payment number transaction to transfer funds into the account identified in the allocated personal payment number. Support for these amendments can be found throughout the disclosure as originally filed, for instance, at page 5, lines 12-16, page 8, line 13 to page 14, line 5, page 11, lines 19-25 and page 13, lines 8-25. Dependent claims 15, 16, 19 and 20 have been amended to conform to changes made in their respective parent claims or to otherwise correct typographical errors and improve readability.

Support for the subject matter for new claims 21 and 22 can be found, for example, in the original specification, at page 9, lines 11-23 and Figure 1.

New independent claim 23 finds support throughout the original disclosure, for instance in the specification at page 5, lines 12-16, page 9, lines 6-24, page 11, lines 19-25, page 13, line 21-25, page 15, lines 20-24 and page 16, lines 8-14 and lines 18-22 and Figures 1-3.

Support for new independent claim 24 and dependent claims 25, 26 can be found in the specification, at page 9, lines 6 to page 10, line 2, page 11, lines 19-25, and pages 18 to 24, for instance.

Subject matter recited in new independent claim 27 is described throughout the specification, drawings and claims, for example, at page 8, lines 13-24, page 11 to page 13, page 18, line 23 to page 24, line 11, page 18 to page 24 and Figures 1-3.

New dependent claims 28-34 respectively find support in the specification at page 13, lines 10-11; page 13, lines 15-16 and page 17, lines 20-21; page 6, lines 16-18 and page 13, lines 9-10; page 16, lines 8-13 and page 17, lines 19-23; page 6, line 15-16 and page 13, lines 11-13; page 17, lines 23-24; and pages 18-24.

The Objections to the Title and Abstract

The Office Action includes an objection to the title of the invention for allegedly not being descriptive, and an objection to the abstract for including information also present in the title and for including a phrase which can be implied. Applicants respectfully submit that the title and abstract, as amended, fully comply with the requirements of 37 C.F.R. §1.72. It is noted that Applicants have retained some similarly stated subject matter in the invention title and abstract because its removal is not be required under Rule 1.72.

All Claims Recite Statutory Subject Matter Under 35 U.S.C. §101

The Office Action includes a rejection of claims 1-20 under 35 U.S.C. §101, as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed.

Claim 1 is directed to a memory storing a data structure. The claimed memory is an article of manufacture, and thus qualifies as a statutory category under §101. Furthermore, it is respectfully submitted that the invention has practical application in the technical arts. For example, the personal number format has practical use in a computer network for facilitating a financial transaction between a payer and a payee.

In the rejection, the Office Action refers to *In re Lowry*¹, and states: [t]he information are merely stored to be read or outputted by a computer without any functional relationship, and thus do not impart functionality to the computer.” To the extent that this statement in the Office Action appears to allege that claim 1 merely recites information in the abstract, Applicants respectfully disagree. The claimed personal payment number format comprises routing information, which represents a destination of an institution, and a unique identifier of a payee associated with the institution. This information of a personal payment number identifies an account into which funds can be transferred but from which funds cannot be transferred, which is a useful, concrete and tangible result in the area of technology related to performing financial transactions in a computer network.

¹ While the Office Action actually refers to “*In re Lowrey*,” it appears its intent was to cite *In re Lowry* 32 F.3d 1583 32 USPQ2d at 1034-1035.

It should be mentioned that the issue decided in *In re Lowry* was not whether claims were non-statutory. Rather, the *Lowry* court concluded that the Board erred in its determination that claimed data structures are analogous to printed matter, and thus erred in its subsequent refusal to give “patentable weight” to the claimed data structure under its § 102 and § 103 review. Indeed, *Lowry* mentions, at 1582, that the Board reversed a rejection under 35 U.S.C. §101 of claims 1-5 of *Lowry* directed to a memory containing stored information (the Board found that claims 1-5, as a whole, recited an article of manufacture).

Furthermore, the claimed data structure provides a variety of other useful tangible results. For instance, the claimed identification of an account in which funds can be transferred but from which funds cannot be transferred provides a secure way for a payee to receive payments without worrying about possible misuse of the personal payment number, for instance, to make purchases that would debit the payee's account (see page 5, lines 25-27 and page 6, line 12.) Additional features provided by the claimed data structure include its use for payments in situations where revealing an account number would be considered risky, and the convenience of not having to use secure means to transmit the personal payment number to a payer (see page 6, lines 12-18 and page 13, lines 8-16), for example.

With respect to amended claim 10, and hence also its dependent claims, it is respectfully submitted that the claimed invention is directed to a *machine*, which is one of the categories named in 35 U.S.C. §101. Moreover, claim 10 recites a combination of elements in means-plus-function format that comprise a personal payment number processing system. Such claims directed to a computer-implemented apparatus drafted in mean-plus-function format have been recognized by the courts as statutory machine claims. See *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) and *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994). The claimed machine furthermore produces a useful, concrete and tangible result. For instance, the personal payment number represents information about a payee's account, a useful, non-abstract result that facilitates a transactions involving the transfer funds into the account identified in the personal payment number.

It is respectfully submitted that the process recited in amended claims 17-20 are statutory for the same reasons given above with respect to claim 10. The position of the Office Action based on the decision in *In re Schrader* 22 F.3d at 294-295, 30 USPQ2d at 1458-1459 is not pertinent to the amended claims because the claimed process does not consist solely of mathematical operations in the abstract. In contrast, the claimed processing method of allocating personal payment numbers including information about a

payees account produces a useful, non abstract result that facilitates the transfer of funds into the account identified by the allocated personal payment number.

All Claims Comply with 35 U.S.C. §112

The Office Action includes a rejection of claims 1, 10 and 17 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. This rejection is respectfully traversed.

The Office Action, at page 5, includes the statement: "Claims 1, 10 and 17 are vague and indefinite" and that "it is unclear which funds are being transferred into or being received from each account or which fund cannot be transferred into." Applicants dispute these allegations by the Examiner and submit that the claims are definite, for the following reasons.

First, the mere assertion that claims 1, 10 and 17 are "vague and indefinite," does not appraise Applicants of what language in these claims allegedly does not to set forth the scope of invention with reasonable clarity and particularity. Absent a showing to the contrary, Applicants submit that these claims are definite.

Second, with respect to the allegation concerning the lack of clarity, Applicants submit that the claimed feature of a personal payment number "identifying an account into which funds can be transferred but from which funds cannot be transferred" would be clear to one of ordinary skill in the art. The claims recite that a personal payment identifies an account into which funds (i.e., money) can be transferred, but from which funds (again, money) cannot be transferred. It is not believed that it should be necessary for Applicant to recite *which* funds can be transferred into the claimed account and *which* funds cannot be transferred from the account because the meaning of these claimed features would be self-evident to one of ordinary skill in the art, especially when read in light of the specification. It is axiomatic that claims are not to be read in a vacuum. Rather, they are to be read in light of the content of the particular application disclosure, the teachings of the prior art,

and the claim interpretation that would be given by one possessing the ordinary skill in the pertinent art at the time the invention was made. See MPEP §2173.02.

For at least these reasons, it is respectfully submitted that claims 1, 10 and 17 fully comply with Section 112, second paragraph. Applicants therefore request the Examiner to withdraw this rejection.

U.S. Patent No. 6,032,133 Fails to Disclose The Combination of All Claimed Features

The Office Action includes a rejection of claims 1-20 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,032,133 to Hilt et al. (hereinafter, "Hilt et al."). To the extent that the Office may consider this rejection to apply to the amended claims, this rejection is respectfully traversed.

The cited document must disclose the combination of all of the claim features to establish a *prima facie* case of anticipation (see, MPEP § 2131). The rejection included in the Office Action cannot stand at least because the Hilt et al. patent does not disclose each and every claim feature of the amended independent claims. The differences between the amended claims and the Hilt et al. patent become apparent in the following analysis.

Independent claim 1 is directed to memory for storing data for facilitating a financial transaction originating from a payer in a computer network. The memory stores a data structure for access by a payer to initiate a financial transaction originating from the payer and includes, *inter alia*, a *personal payment number format* comprising:

- (1) routing information to direct financial transaction information to a particular institution among a plurality of institutions using the computer network, and
- (2) a unique identification of a payee *associated with said particular institution*.

In connection with this claimed subject matter, the Office Action asserts that the Hilt et al. patent discloses routing information in Figure 4. However, it is respectfully submitted that

neither Figure 4 nor its description in the Hilt et al. patent disclose the claimed data structure.

First of all, Hilt et al. does not mention anything with respect to *a number format* that includes both routing information and a unique identifier as claimed. In contrast, the Hilt et al. patent describes a system in which a consumer (i.e., "consumer C") has to have a bank from which he wishes to pay bills, and that the consumer's bank must be a participating member of a bill payment service network to which the biller's bank (i.e., Bank B) also is a participating member. When the consumer initiates a transaction, the consumer sends a bill pay order (i.e., "bill pay order 122") to his bank (i.e., "Bank C"). The bill pay order described in Hilt et al. includes:

- (a) a biller reference number (BRN),
- (b) a consumer-biller account number (i.e., a "C-B account number" that the consumer obtains by referring to an invoice 120 (column 13, lines 40-44)),
- (c) source of funds for payment (an account designated by consumer C),
- (d) a desired transaction date,
- (e) an amount to pay, and
- (f) an authorization to pay the stated amount to that BRN.

(See column 10, lines 50-55 and column 13, lines 50-53.) It is clear that no information in items (a) to (f) of a bill pay order 122 pertains to a personal payment number format that including both routing information *and* a unique identification of a payee as claimed.

Furthermore, there is no mention in Hilt et al. that a data structure accessible to payment originator (e.g., a consumer C in Hilt et al.) includes routing information *to direct financial transaction information to a particular institution among a plurality of institutions using the computer network*, where the particular institution is *an institution associated with a payee*. By contrast, consumer C of the Hilt et al. system does not appear to any have knowledge of routing information that directs a financial transaction to an institution associated with a payee as claimed. For instance, the Hilt et al. patent describes that consumer *Bank C*, not consumer C, obtains a bank identification (BID) identifying a biller

bank (i.e., Bank B) by referencing a universal biller reference file 108 (UBF). After obtaining the BID, the consumer bank C enters the BID of the biller along with the BRN to identify the destination bank in a payment message 124. (See column 10, line 64 to column 11, line 1 and column 14, lines 29-30, column 15, lines 16-19, column 16, lines 17-20 and Figure 6, items 122, 124, 158 and 160.) Hence, it is respectfully submitted that the Hilt et al. patent also does not disclose a personal payment number format including routing information as claimed.

The Hilt et al. patent, in fact, actually appears to teach away from a payer having access to information included in a personal payment number format, as claimed, because the Hilt et al. patent describes that "the BID relieves consumer C from having to know which bank to send payments." (See column 15, lines 16-17.) Moreover, the consumer C can access information in the UBF to view *only* the name and address of the biller (to validate that the correct BRN was entered during a payment or enrollment process). (See column 15, line 7-10 and column 19, lines 35-36.) The Hilt et al. patent therefore appears to suggest that access to routing information would not be provided to a payer.

For at least the above reasons, Hilt et al. does not disclose each and every recited feature of claim 1, and hence also its dependent claims.

Similar distinctions are recited in amended independent claim 10. For instance, claim 10 recites, among other features, means for allocating personal payment numbers to payees, each personal payment number *including routing information* and information identifying a payee, wherein said personal payment number identifying an account associated with a payee into which funds can be transferred but from which funds cannot be transferred, means for initiating a personal payment number transaction *originating from a payer utilizing an allocated personal payment number*, and means for routing the personal payment transaction to a destination *based on the routing information included in the allocated personal payment number*. It is respectfully submitted that the Hilt et al. patent does not disclose the claimed combination of these features.

As pointed out above, the Hilt et al. patent does not disclose or suggest that a personal payment number including routing information is accessible by a payer. In contrast, a biller reference number (BRN), according to Hilt et al., is allocated by a biller network to a biller by either issuing a BRN to the biller in response to a request by the biller, or by assigning a pool of numbers in advance to a biller bank and drawing a BRN for a biller from this pool. (See column 19, lines 21-38.) In the latter case, the biller bank informs the payment network of the activation of a BRN from the pool and the format of acceptable C-B account numbers plus other biller-unique data normally printed on a payment coupon for verification that the BRN is the BRN of the desired biller. The payment network then broadcasts/publishes the BRN and related data to all participating consumer banks. Thereafter, the biller identifies its BRN to its customers. On the consumer's side, the above-noted items (a) to (f) are supplied to the consumer's bank when initiating a bill pay order 122. Comparing this information in items (a) to (f) and the information provided to a biller (i.e., a BRN, BID etc., as shown in UBF file the 108/158 of Figure 5), it is clear that information in common between the two (i.e., a BRN and a C-B account number) does not disclose the claimed means for routing a personal payment transaction to a destination *based on the routing information included in an allocated personal payment number*. Hence, the Hilt et al. patent does not disclose the claimed combination of each and every feature set forth in independent claim 10.

Independent claim 17 is directed to a personal payment number processing method that similarly recites subject matter not disclosed in the Hilt et al. patent. Hence, claim 17 is patentable for at least the reasons given above for claim 10.

Claims 2-9, 11-16, 18-20, and new claims 21 and 22 depend from one of claims 1, 10 and 17 and therefore are patentable for the reasons given above. In addition, these dependent claims 2-9 recite combinations including additional features not disclosed in the Hilt et al. patent. For example, claim 5 recites that the personal payment number format is formatted in accordance with standard credit/debit card formats. In connection with this claimed subject matter, the Office Action refers to column 18, line 26 to column 20, line

25 of the Hilt et al. patent. It is respectfully submitted, however, that the portion of the Hilt et al. patent cited in the Office Action does not disclose a personal payment number is formatted with standard credit/debit card formats, much less a payer accessible format that includes routing information and a unique identifier, as claimed. By contrast, the claimed personal payment number formatted in accordance with standard credit/debit card formats enables a payer to originate a payment that is processed in an existing credit card system using normal credit card terminals/software. For instance, the personal payment number can be e-mailed to a purchaser to allow the purchaser to complete the purchase at a payment service of his/her choice.

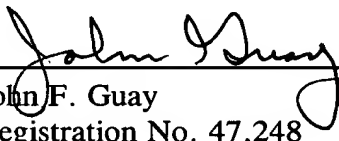
A standard credit/debit card format for a personal payment number format is but one example of additional, more specific, features of the invention that are recited in the various dependent claims, which are likewise not disclosed by the Hilt et al. patent. In view of the foregoing, however, a detailed discussion of each of those additional distinctions is not believed necessary at this time.

New claims 23, 24-26, and 27-34 are respectively directed to a database storing personal payment numbers accessible by an transaction originator, a method of processing a one-way credit-only funds transfer, and a method of implementing a personal payment number transaction. It is respectfully submitted that the Hilt et al. patent does not disclose or suggest the subject matter set forth in these claims.

For all the foregoing reasons, Applicants respectfully submit that the present application is in condition for allowance. Prompt notification of same is earnestly solicited.

Respectfully submitted,

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